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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/602,372 | 06/23/2003 | Dany Berube | P038 | 1584 |
| 758 | 7590 | 03/06/2007 | EXAMINER | |
| FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041 | | | ADAMS, AMANDA S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3731 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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| 3 MONTHS | 03/06/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | |
|------------------------------|--------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/602,372 | BERUBE ET AL. |
| | Examiner Amanda Adams | Art Unit 3731 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 February 2007.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,17 and 18 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,17 and 18 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. **Claim 1** is rejected under 35 U.S.C. 102(b) as being anticipated by Yates et al (US 5,403,312).

3. Yates discloses the invention substantially as claimed including a first jaw member having a recess in an inner surface thereof adapted to receive the ablation device therein; a second jaw member opposed to the inner surface of the first jaw member (figs. 3 and 19); and a structure operably attaching the first jaw member to the second jaw member for selectively effecting closure of the first and second jaw

members (fig. 3 [38]); and a transmurrality system including at least two electrodes disposed near the recess and adapted to selectively transfer electrical signals therebetween through the target tissue to measure at least one of conduction time, conduction distance, conduction velocity, phase angle, and impedance through at least a portion of the targeted biological tissue for monitoring the transmurrality of an ablation lesion formed therein (figs. 17-19 and col. 8, lines 20-36).

4. **Claims 1 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Hooven et al (US 6,517,536).**

5. Hooven discloses the invention substantially as claimed including a first jaw member having a recess in an inner surface thereof adapted to receive the ablation device therein; a second jaw member opposed to the inner surface of the first jaw member (fig. 32; locations of electrodes [94] and [96], which comprise parts of the ablation device, rest within recesses located on the inner surface of jaw members [78] and [80]); and a structure operably attaching the first jaw member to the second jaw member for selectively effecting closure of the first and second jaw members (fig. 28 [76]); and a transmurrality system including at least two electrodes disposed near the recess and adapted to selectively transfer electrical signals therebetween through the target tissue to measure at least one of conduction time, conduction distance, conduction velocity, phase angle, and impedance through at least a portion of the targeted biological tissue for monitoring the transmurrality of an ablation lesion formed therein (col. 8, lines 48-67).

6. **Regarding claim 17**, Hooven discloses that the first and second jaw members extend in an elongated direction and are hinged together for relative rotation between open and closed configurations along an axis substantially aligned along the elongated direction (figs. 28 and 29; hinge [76] allows rotation along an axis substantially aligned along the axis of elongate portions of the distal end of the jaws).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over Truckai et al (US 2003/0114851).

9. Truckai discloses the invention substantially as claimed including a first jaw member with a recess on the inner surface (fig. 2 [56]) a second jaw member ([55]), and a structure operably attaching the first jaw member to the second jaw member capable of operatively engaging an ablation device upon a target tissue disposed between the jaw members (fig. 4). Truckai also discloses at least two electrodes near the recess (fig. 2, [55] and [56]).

10. Truckai teaches as a part of the transmurality system, in an alternative embodiment, sensors in contact with the tissue to measure temperature or impedance through a portion of the tissue (par. 55). Adding these sensors to the device described

above would improve the user feedback of the transmularity system, therefore it would have been obvious to have the sensors on the device as disclosed above.

11. **Claims 17 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Truckai et al (US 2003/0114851) in view of Hooven et al (US 6,517,536).

12. **Regarding claim 17**, Truckai does not teach the following which is taught by Hooven. As cited above, Hooven teaches first and second jaw members that extend in an elongated direction and are hinged together for relative rotation between open and closed configurations along an axis substantially aligned along the elongated direction (figs. 28 and 29; hinge [76] allows rotation along an axis substantially aligned along the axis of elongate portions of the distal end of the jaws). Changing the shape of the jaws of Truckai would allow the user of the device to grasp hard to reach tissue more easily. Therefore it would have been obvious to change the shape of the jaws so that they are similar in structure to those of Hooven.

13. **Regarding claim 18**, Truckai further discloses a clamp accessory in which the hinged attachment of the jaw members is disposed to translate laterally to the axis for expanding the spacing between the first and second jaw members in the open and closed configurations (fig. 4, par. 41).

14. **Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over Truckai et al (US 2003/0114851) in view of Taylor et al (US 6,322,558).

15. In an alternative interpretation of the claim language, Truckai discloses the invention substantially as claimed above. Taylor teaches a transmularity system that may be placed within the recess of the first jaw member of Truckai, the transmularity

system of Taylor including at least two electrodes to selectively transfer signals through the target tissue to measure temperature (col. 8, line 66 – col. 9, line 19; fig. 1 [14] and fig. 3). This allows the user of the device to sterilize the clamping device between uses and replace the transmurality system when necessary. Therefore it would have been obvious to use the device of Truckai with an independent transmurality system.

Response to Arguments

16. Applicant's amendments with respect to the specification have been considered and the previous rejection has been withdrawn.
17. Applicant's arguments with respect to claims 1, 17, and 18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda Adams whose telephone number is (571) 272-5577. The examiner can normally be reached on M-F, 8:00am-5:00pm, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ASA 2/26/07

glen
GLENN K. DAWSON
PRIMARY EXAMINER